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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,332	01/31/2001	Michael J. Swain	200308264-2	5528

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IP ADMINISTRATION LEGAL DEPARTMENT
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EXAMINER	
BELIVEAU, SCOTT E	
ART UNIT	**PAPER NUMBER**
2614	

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/773,332	SWAIN ET AL.	
	Examiner	Art Unit	
	Scott Beliveau	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 May 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-14 and 16-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-14 and 16-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 April 2005 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 14, and 28 have been considered but are moot in view of the new ground(s) of rejection.

With respect to applications arguments pertaining to the rejection under Ellis et al., the examiner respectfully disagrees that the reference fails to anticipate the claimed limitation of ". . . providing a searchable index to the . . . streamed video-audio data being recorded . . . " (Claim 1) or "providing a searchable index to the streamed multimedia data being recorded" (Claim 28). The claims as presented do not necessarily require the specific timing or when the step of providing a searchable index for a program being recorded need be performed. For example, the claims do not require that the searchable index for a stream being recorded necessarily be provided at the same time that the program is being recorded as opposed to being provided at a later point in time subsequent to the recording of the program. Accordingly, a new grounds of rejection is presented in light of the previously presented Ellis et al. reference.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3-6, 8, 9, 11-14, 16-19, 21, 22, and 24-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Ellis et al. (US Pub No. 2003/049988).

In consideration of claim 1, Ellis et al. discloses a "method of providing to a user desired ones of . . . live broadcasts shifted in time". The method comprises "proving a schedule of events to be broadcast live over [a] global computer network" such as the Internet [18/20] (Para. [0059] and [0065]) from "at least one node broadcasting live events over the network" [16] wherein the schedule or program guide "enables the user to formulate a request for content of a broadcast of at least one certain future event" (Para. [0074] and [0076]). Subsequently, the "working server" [24/29], "in response" to "receiving from a user a request for content of the broadcast of at least one future event" comprising the "date, time and network location of respective broadcasts of each requested event" necessary to uniquely identify the particular event for recording (Para. [0076], [0084], and [0088]), "records" the "respective broadcast . . . being in the form of live streamed video-audio data over the global computer network" or Internet [18/20] (Figure 5; Para. [0059], [0088], and [0097]) and is operable to "provide a searchable index to the recorded streamed video-audio data and to the

streamed video-audio data being recorded" subsequent to its recording (Figures 18A-F; Para. [0145] – [0149]). For example, as illustrated in Figure 18D, the user is provided with a searchable index of recorded programs (ex. "Braveheart") and Figure 18F illustrates a searchable index of programs (ex. "Beverly Hills") scheduled to be recorded. Assuming that it is currently "6/30/99 8:00 PM), the system will record the program entitled "Beverly Hills" and will subsequently provide a "searchable index to the audio-video data being recorded" as illustrated in Figure 18D. As aforementioned, the claim does not require that the system necessarily provides the "searchable index" during the recording of the program. Finally, "upon [a] user command to view a certain one of the requested events", the working server [24/29], "provides the recorded streamed video-audio data corresponding to said certain one of the requested events" to a "digital player" [36] such that the "viewing [is] in a manner time shifted from original broadcast of the certain one of the requested events" (Para. [0091] – [0093], [0104], [0152], and [0153]).

Claim 14 is rejected in view of claim 1 wherein the method further comprises a "user interface means" in the form of an electronic programming guide to facilitate the request for recording of "future events" (Para. [0076]). As aforementioned, the "working server" [24/29] further "provides a searchable index to the recorded streamed audio-video data and to the streamed video-audio data being recorded" subsequent to its recording (ex. Figures 18A-F).

Claim 28 is rejected wherein the Ellis et al. method of providing "broadcast data shifted in time". The method involves "receiving requests from users to record respective desired broadcast programs" and "recording streamed multimedia data forming the respective desired

broadcast programs" (Para. [0076], [0084], and [0088]). The viewers are subsequently "enabled" so as to "view a corresponding program at a time subsequent to [the] original beginning of broadcasting of said program" (Para. [0091] – [0093], [0104], [0152], and [0153]). As previously set forth, the "steps of recording and enabling include providing a searchable index to the streamed multimedia data being recorded" subsequent to its recording completion (ex. Figures 18A-F).

Claims 3, 4, 16, and 17 are rejected wherein the "working server" [29] and the "digital player" [36] are "local to each other in the network such that the stop of recording at the working server includes recording local to the digital player". Alternatively, the "working server" [24] may be at a "third party site in the network remote from the digital player, such that the step of recording includes recording at a network site remote from the digital player" (Para. [0086]).

Claims 5 and 18 are rejected wherein the method may further include "recording some of the broadcasts locally to the digital player" and "recording different ones of the respective broadcasts remotely from the digital player" such that the "providing the recorded streamed video data" may be "synchronized . . . in a manner transparent to the user" (Para. [0086], [0152], [0153], and [0156]). In particular, the system determines whether or not to store a program remotely or locally based on the number of requests and subsequently "transparently" presents the requested media to the user.

Claims 6, 19, and 29 are rejected wherein the recording includes "caching to cache storage" [13/15] the "streamed video-audio data corresponding to the respective broadcasts of the requested events" (Para. [0078] and [0079]).

In consideration of claims 8, 9, 21, and 22, the Ellis et al. reference discloses that the "working server" [24/29] provides (ex. Figure 18D) a "searchable index . . . [including] header information from respective original broadcasts" as a means to search for a recorded program of interest based on a plurality of criteria (ex. time, category, title, etc.) (Para. [0118], [0122], and [0143]).

Claims 11 and 24 are rejected wherein the Ellis et al. reference discloses the limitation wherein the recorded media appears in the electronic program guide and the user may subsequently request and display a "respective summary of the corresponding event" (Figures 11A-C; Para. [0125] and [0154]).

In consideration of claims 12, 13, 25, and 26, the Ellis et al. reference discloses that "scheduling broadcasts to be recorded" is performed "across multiple users and their requests" that media may be stored for a "length of time determined according to user demand across multiple users" such that once all users have demanded to view a recorded program that it is subsequently deleted (Para. [0167] – [0169]).

Claim 30 is rejected wherein the "caching overwrites and saves streamed multimedia data as a function of number of user requests for the corresponding broadcast program" (Para. [0081]).

Claim 31 is rejected wherein the "enabling user viewing includes supporting a multimedia rendering of the corresponding desired broadcast program . . . through a television." (Para. [0104)].

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 7, 10, 20, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (US Pub No. 2003/0149988) in view of Browne et al. (WO 92/22983).

In consideration of claims 7, 10, 20, and 23, the Ellis et al. reference discloses the particular usage of automatically deleting or "overwriting the streamed video-audio data in the cache storage" subsequent to watching or after a predetermined period of time. However, the reference does not particularly disclose nor preclude the deletion based either "the event viewed longest ago by the user" or "the least recent broadcast event". Furthermore, the reference does not provide an interface so as to enable the user to "indicate preference for saving or deleting the streamed video-audio data when the cache storage is full".

The Browne et al. (WO 92/22983) reference discloses that it is known in the art so to "provide interface means for enabling the user to indicate preference for saving or deleting

streamed video-audio data when the cache storage is full" (Figures 3 and 6; Page 18, Line 29 – Page 19, Line 30) wherein an event is deleted/overwritten in the cache based on "the least recent broadcast event". Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so to modify the Ellis et al. interface so as to provide ability for the user to designate a cache / storage management deletion functionality for the purpose of providing the user with the means and flexibility to control storage options of a storage device of limited capacity.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Young et al. (US Pat No. 5,532,754) reference provides evidence as to the existence of providing the user with a searchable index while a program is being recording (Col 7, Lines 48-63).
- The Omoigui (US Pub No. 2005/0080847) reference discloses providing a method and apparatus for providing a searchable index for streaming presentations.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343. The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SEB
August 3, 2005

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